

REMARKS

Upon entry of the present amendment, claims 1-5, 7-24 and 31-32 will be pending in the above-referenced patent application and are currently under examination. Claim 1 has been amended. Support for the amendments can be found throughout the specification and in claim 6 as filed. Claim 6 has been canceled. Reconsideration of the application is respectfully requested. Claims 3-20 and 31-32 have been acknowledged by the Examiner as allowable if rewritten in independent form.

The claims are rejected in various combinations under 35 U.S.C. § 112, first paragraph, 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a). Each of these rejections and objections is addressed below in the order set forth by the Examiner.

I. REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, ENABLEMENT

Claims 21-24 have been rejected under 35 USC § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicants respectfully traverse the rejection.

The test for enablement is whether the experimentation needed to practice the invention is undue or unreasonable (*Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916)) such that “the disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention” (MPEP § 2164.01).

Applicants note that amended claim 1 has been amended to the scope of allowable claim 6, where R¹ is Formula II. Thus, claim 1 is now in allowable form. Claims 21-24 are drawn to a method for treating HIV viral disease comprising administering a compound according to amended claim 1. The Examiner alleges that claims 21-24 do not reasonably provide enablement for the methods of claims 21-24 where R¹ is other than Formula II. The Examiner also recognizes that claims 21-24 are enabled for compounds of Formula I where R¹ is Formula II (Office Action, page 2, last paragraph). Since amended claim 1 has been amended to the scope of canceled claim 6, where R¹ is Formula II, claims 21-24 are enabled under 35 U.S.C.

§ 112, first paragraph. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

II. REJECTIONS UNDER 35 U.S.C. § 102(B)

Claims 1 and 2 have been rejected under 35 USC § 102(b) as allegedly being anticipated in view of Endermann *et al.* DE 10141271, Fincke *et al.* DE 2451899, Vulliet *et al.* J. Agric. Food Chem. 50, 1081-1088, 2002, Yuan *et al.* Tetrahedron Letters 37(12), 1945-1947, 1996, Dovlatyan *et al.* Armyanskii Khimicheskii Zhurnal 33(11), 943-946, 1980 (CAPLUS Abstract), Scott *et al.* U.S. Patent No. 3,101,335, and Slotta *et al.* Berichte der Deutschen Chemischen Gesellschaft (Abteilung) B: Abhandlungen 62B, 137-145, 1929 (CAPLUS Abstract). Applicants respectfully traverse the rejections in view of the comments below.

A claim is considered to be anticipated under 35 USC § 102(b) if “the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.” In order for a claim to be anticipated by a reference, the reference must teach every element of the claim (MPEP § 2131):

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As discussed in detail below, the presently claimed invention is not anticipated in view of any of the cited references as all the references fail to teach every element set forth in the claims of the instant invention. Applicants respectfully traverse the rejection in view of the comments below.

Applicants note that amended claim 1 has been amended to the scope of allowable claim 6, where R¹ is Formula II. No art has been cited against claim 6. Thus, claim 1 is now in allowable form. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

III. REJECTION UNDER 35 U.S.C. § 103(A)

Claims 1 and 2 have been rejected under 35 USC § 103(a) as allegedly being obvious in view of Fincke et al. Applicants respectfully traverse the rejection in view of the comments below.

A claim is considered obvious “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains” (35 USC § 103(a)). Several elements are necessary in order to make a prima facie case of obviousness (MPEP § 2143):

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Accordingly, in order for the claims of the instant application to be obvious in view of the cited art, each reference must (1) provide some suggestion or motivation to modify the reference in order to teach all of the above elements; (2) provide a reasonable expectation of success of making a compound of the instant application; and (3) teach or suggest at least the above listed claim elements. As discussed in detail below, none of the cited references satisfies all three requirements under MPEP § 2143. Applicants respectfully traverse the rejection in view of the comments below.

Applicants note that amended claim 1 has been amended to the scope of allowable claim 6, where R¹ is Formula II. No art has been cited against claim 6. Thus, claim 1 is now in allowable form. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

Appl. No. 10/816,161
Amdt. dated December 5, 2006
Reply to Office Action of September 6, 2006

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



Annette S. Parent
Reg. No. 42,058

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 925-472-5000
Fax: 415-576-0300

ASP:art
60914876 v1